

## DISCUSSION OF EXAMINER'S OFFICE ACTION

### Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 21-26 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 21-26 of prior U.S. Patent No. 6,426,374. This is a double patenting rejection.

Claims 21-26 of the present invention are duplicate claims of the already patented U.S. 6,426,374.

### Applicant's response

Claims 21-26 have been canceled.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Claims 1, 3, 4, 7, 13-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-7, 9-20 of U.S. Patent No. 6,426,374. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

The patented invention '374 discloses composition for foundry molds, which contains binder and divalent sulfur additive. The foundry binder is utilized in cold-box foundry with phenolic urethane binder system. The mix is introduced into the shape to make mold, an internal core, cured and removed from the shape. The internal core is introduced into casting assembly, liquid metal, aluminum, is poured and allowed to solidify thereby forming metallic part or object.

The difference between the present invention and the already patented invention is the type of the divalent sulfur source.

Already patented invention '374 discloses use of elemental sulfur, while present invention teaches use of thiuram. Therefore only those claims of the present invention are rejected over the patented invention that do

not specifically disclose the divalent sulfur compound.

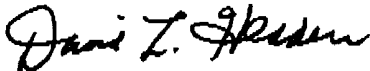
### **Applicant's response**

The claims have been amended to define an invention that is patentably distinct from the invention claimed in U.S. Patent 6,426,374. All of the claims are now restricted to thiuram

### **CONCLUSION**

Applicants submit that the application is now in condition for allowance and respectfully request a notice to this effect. If the Examiner believes further explanation of Applicants' position is needed, Applicants' attorney will discuss this matter over the telephone or visit the Examiner personally if this may be useful.

Respectfully submitted,



David L. Hedden  
Attorney for Ashland Inc.  
Registration No. 29,388

Ashland Inc.  
P.O. Box 2219  
Columbus, Ohio 43216

Phone: (614) 790-4265  
Fax: (614) 790-4268  
e-mail: dlhedden@ashland.com

David L. Hedden  
Senior Patent, Trademark, and Copyright Counsel  
Law Department  
dlhedden@ashland.com  
Tel: (614) 790-4265  
Fax: (614) 790-4268

Ashland Inc.  
P.O. Box 2219  
Columbus, OH 43216

**Facsimile Message**

Date: August 27, 2003  
To: Examiner K. Wyrozebski, Art Unit: 1714  
Firm: United States Patent and Trademark Office  
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Per your request I am sending a copy of the revised amendment.

Thank you for your assistance.



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